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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,733	11/08/2002	Yoichi Kawashima	0388-020198	4588

7590 02/12/2007
Russell D Orkin
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/049,733	Applicant(s) KAWASHIMA ET AL.	
	Examiner Jila M. Mohandesi	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/11/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments, see remarks filed January 11, 2007, with respect to the nonstatutory double patenting rejection of claims 3-5 and 17-24 in view of the newly amended claims of the copending application 10/493,877 have been fully considered and are persuasive. Therefore, the rejection under nonstatutory double patenting has been withdrawn and the finality of the previous Office action is hereby withdrawn. However, upon further consideration, a new ground(s) of rejections are made in view of US patent 6,129,248 (Hagele). The after final amendment filed January 11, 2007 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on January 11, 2007 was filed after the mailing date of the final action final office action on October 10, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. The Japanese search report issued November 1, 2006 has not been considered since it is not in English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 3-5 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagele (US 6,129,248). Hagele '248 discloses an eye drop container, comprising: a flexible hollow body portion (dropper bottle 2 with deformable reservoir 4) having a closed end for containing a liquid therein; and a dispensing body portion (10, 210, 310) having a tip end spaced from the closed end of the hollow body portion, the liquid free to move within the container between the flexible body hollow portion and the dispensing body portion, the dispensing body portion, comprising: a first hollow body segment having an external surface and an opposite internal circular surface, with the internal circular surface having decreasing diameter as the distance from the tip end decreases (frustoconical extension surface 60, 260, 360, see Figures 1, 3 and 8 embodiments); and a second body segment extending from the tip end into the first segment, the second segment having an outside circular surface and an opposite internal surface, with the internal surfaces of the first and second segments facing one another, spaced from one another, and the external surface of the second segment having increasing diameter as the distance from the tip end decreases, with the second segment at a predetermined distance from the tip end terminating in a small-diameter instilling hole

(discharge tube 22 & 322 which extends away from the opening 20 of the tip 10, 210 and 310 toward the floor 5 of the reservoir 4, see Figures 6 and 9 embodiments), wherein applying a predetermined pressure to the body portion moves a predetermined amount of the fluid in the container through the instilling hole. Hagele'248 is silent as if the hollow body portion and the dispensing body portion are integrally and unitarily formed as one piece. However Hagele '248 discloses that the hollow body portion (deformable dropper bottle) and the dispensing body portion (tip 210) are preferably made from resilient thermoplastic material, which is compatible with injection molding techniques (see column 4, lines 53-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the hollow body portion and the dispensing body portion integrally and unitarily formed as one piece, for easier and cheaper manufacturing.

With respect to claim 3, note the threaded portion (9) for detachable meshing a cap (12) to seal the second body segment of the dispensing body portion.

Hagele '248 *does not expressly disclose* a concave portion depth range, or tip opening diameter ranges. The concave portion depth range, or tip opening diameter ranges are result effective variables since these values affect the fluid drop size and are at least a result of the overall eyedropper container size. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hagele '248 to contain these ranges, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesche and Slaney*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

The product-by-process limitation in claims 21, 22 and 23 result in no structure that is different from Hagele '248. The Product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, "*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. Note also that most of the distinctions argued are not present in the claims.

Response to Arguments

6. Applicant's arguments with respect to claims 3-5 and 17-24 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Art Unit: 3728

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
February 08, 2007